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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Harlan A. Hurwitz

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EXAMINER

KIM, STEVEN S

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,109	Applicant(s) HURWITZ ET AL.	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the RCE filed on 2/20/2009. Claims 1-9 and 11-20 are pending. Claims 9 and 21-33 are cancelled. Currently amended claims are claims 1, 12, and 20.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/2009 has been entered.

Response to Amendment/Arguments

3. The Applicant has amended the claims in an effort to address the rejections detailed in the previous office action dated 11/25/08, hereinafter referred to as "OA1108".

Claim 1 objection

Claim 1 was sufficiently revised to address the objection on claim 1 in OA1108. Therefore, the Examiner withdraws the objection on claim 1.

35 USC 112 rejections on claims 1-9 and 11

Art Unit: 3685

Claim 1 was sufficiently amended to address the 35 USC 112, 2nd paragraph rejection, in OA1108. Therefore, the Examiner withdraws the 35 USC 112 rejections on claims 1-9 and 11.

6. 35 USC 112 rejection on claim 20

Claim 20 was amended to address the 35 USC 112 rejection in OA1108. While the amendment sufficiently addresses the rejection in OA1108, the amendment raises a new 35 USC 112, 2nd paragraph, rejection. For example, claim 20 is directed towards a system, i.e. an output device and a controller coupled to the output device. The claim, however, recites steps performed by the controller. A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (Ex Parte Lyell, 17 LISPQ2d 1548 (B.P.A.I. 1990)).

7. Claim 1 clearly recite which devices perform the steps of the method

The Examiner respectfully disagrees that the amended language clearly recite which device perform the steps recited in claim 1, i.e. causing steps. Furthermore, "via" merely recites using such device. The Applicant is advice to amend the claim to replace "via" with "by".

8. 35 USC 103(a) rejections on claims 1-9 and 10-20

The Applicant has amended the claims to recite new feature(s) in an effort to address the 35 USC 103(a) rejections on claims 1-9 and 10-20. Specifically, the claims now recite prompting the responsible party whether the responsibility wants to receive a set of instructions and providing/omitting the set of instructions based on the response

from the responsible party. The Applicant asserts that Drummond cannot reasonably be interpreted as teaching or suggesting "omitting the set of instruction" (see paragraph 2, page 10 on the Applicant's amendment).

Drummond discloses an automated banking machine (see ¶0001) with fault handling features (see ¶0148-¶0150). Drummond further discloses dispatching of fault messages and diagnosis features used in assisting in diagnosis and providing remedial services (see ¶0150-¶0156). Drummond further discloses graphical user interface, e.g. touch screen, that is used to prompt the customer, i.e. whether to proceed with another transaction (see ¶0116). While Drummond does not specifically disclose prompting the responsible party, via the output device, whether the responsible party wants to receive a set of instructions, i.e. on action steps to resolve the payment media handling operation event, and providing/omitting the set of instructions based on the receive response, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the clearly disclosed prompting features in Drummond to prompt the responsible party, via the output device, whether the responsible party wants to receive the set of instructions, i.e. on action steps to resolve the payment media handling operation event. One of ordinary artisan would have recognized that prompting ensures responsible party's intention. In regards to providing/omitting the set of instructions based on the receive response, predictable result of prompting would be to provide or omit the set of instructions based on the response of yes or no.

Furthermore, the Applicant written description of the invention does not disclose "providing the set of instructions, via the output device, comprising at least an audio and

Art Unit: 3685

visual message to the responsible party on action steps to resolve the payment media handling operation event when the responsible party wants to receive the set of instructions and omitting the set of instructions when the responsible party does not want to receive the set of instructions". The Applicant discloses prior to the AV clip, instructions, playing, the user would be prompted to indicate whether or not they wish to view the clip (see ¶0232; Fig. 13), but fails to disclose "providing the set of instructions, via the output device, comprising at least an audio and visual message to the responsible party on action steps to resolve the payment media handling operation event when the responsible party wants to receive the set of instructions and omitting the set of instructions when the responsible party does not want to receive the set of instructions".

9. In view of above, the Examiner maintains the 35 USC 103(a) rejections. The Examiner also rejects claims 1-9 and 11 under 35 USC 101. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-9 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court

Art Unit: 3685

precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

12. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

13. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

14. In this particular case, claims 1-9 and 11 fail prong (1) because the step of causing is not tied to a device. Furthermore, “tie” in other steps (e.g. informing/prompting a responsible party via an output device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the instant application discloses prior to the AV clip, instructions, playing, the user would be prompted to indicate whether or not they wish to view the clip (see ¶0232; Fig. 13) in the written description, the written description does not disclose "providing the set of instructions, via the output device, comprising at least an audio and visual message to the responsible party on action steps to resolve the payment media handling operation event when the responsible party wants to receive the set of instructions and omitting the set of instructions when the responsible party does not want to receive the set of instructions".

17. In further reference to claims 1-9 and 11, the written disclosure does not disclose "causing the controller to determine if the responsible party responded to the prompt as wanting to receive the set of instructions or not wanting to receive the set of instruction".

Art Unit: 3685

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

- receiving a response and determining based on response whether the responsible party wants to receive in claim 1; and
- determining based on response whether the responsible party wants to receive in claim 12 and 20.

20. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

21. Per claim 20, the claim is directed towards a system, i.e. an output device and a controller coupled to the output device. The claim, however, recites steps performed by the controller. A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (Ex Parte Lyell, 17 LISPQ2d 1548 (B.P.A.I. 1990)).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-9 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al., US Patent Application No. 2005/0096994, hereinafter referred to as "Drummond".

24. In regards to claims 1, 10 and 20, Drummond discloses a method and system comprising:

- causing a controller to determine that a payment media handling operation event has occurred during the operation of the payment media handling apparatus (see ¶0148-¶0150; Fig. 1; Fig. 2);
- informing a responsible party, via an output device, of the payment media handling operation event (see ¶0148-0153);
- providing a set of instructions, via the output device, comprising at least an audio and visual message to the responsible party on action steps to resolve the payment media handling operation events (see ¶0148-¶0153).

25. Drummond discloses an automated banking machine (see ¶0001) with fault handling features (see ¶0148-¶0150). Drummond further discloses dispatching of fault messages and diagnosis features used in assisting in diagnosis and providing remedial

Art Unit: 3685

services (see ¶¶0150-¶0156). Drummond further discloses graphical user interface, e.g. touch screen, that is used to prompt the customer, i.e. whether to proceed with another transaction (see ¶0116).

26. Drummond does not specifically disclose prompting the responsible party, via the output device, whether the responsible party wants to receive a set of instructions, i.e. on action steps to resolve the payment media handling operation event, and providing/omitting the set of instructions based on the receive response. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the clearly disclosed prompting features in Drummond to prompt the responsible party, via the output device, whether the responsible party wants to receive the set of instructions, i.e. on action steps to resolve the payment media handling operation event. One of ordinary artisan would have recognized that prompting ensures responsible party's intention. In regards to providing/omitting the set of instructions based on the receive response, predictable result of prompting would be to provide or omit the set of instructions based on the response.

27. In regards to claims 2, 4-7 and 15-18, Drummond further discloses wherein the payment media handling operation event comprises at least one of a payment media handling apparatus error, a payment media handling apparatus electronic coupling event, a payment media handling apparatus operation question and a payment media processing event (claim 2) (see ¶0148; ¶0154);

Art Unit: 3685

- (claims 4 and 16) wherein the payment media handling operation event is a payment media handling apparatus error, and the payment media handling apparatus error comprises at least one of a payment media note jam, a payment media coin jam, a payment media note misfeed, a payment media coin misfeed, a payment media note double feed, an unauthorized payment media activity and a fraudulent payment (see ¶0148; ¶0154);
- (claims 5 and 17) wherein the payment media handling operation event is a payment media handling apparatus electronic coupling event, and the payment media handling apparatus electronic coupling event comprises an event which identifies that the payment media handling apparatus is coupled to another electronic device (see ¶0148 - ¶0154; Fig. 2; ¶0053-¶0057; ¶0137); and
- (claims 6 and 18) wherein the payment media handling operation event is a payment media processing event, and the payment media processing event comprises one or more events associated with performance of a payment media operation (see ¶0148-¶0154, fault and status are part of performance of a payment media operation);
- (claim 7) wherein the payment media operation includes at least one of a payment media acceptance operation, a start fund operation, a payment media change dispensing operation, a payment media advance operation and a payment media bank deposit operation (see Fig. 2, Cash Dispenser 42; claim 12, level of currency; claim 10; ¶0148).

Art Unit: 3685

28. In regards to claims 3 and 13, Drummond also teaches wherein the set of instructions further comprises one or more of a visual message, an audio message and a text message (see ¶0151).

29. In regards to claim 8 and 14, Drummond further teaches wherein the responsible party includes at least one of a payment media handling apparatus user, a supervisory entity in the retail store, a supervisory entity not physically located in the retail store, a payment media handling apparatus repair representative, a security representative and a law enforcement official (see ¶0151, technician; ¶0034; ¶0153-¶0154; Fig. 1).

30. In regards to claims 9 and 19, Drummond also discloses wherein the audio and visual message comprises at least one of a computer slide presentation and a video presentation (see ¶0101, use of HTML document to present video and sound and ¶0151).

31. In regards to claim 11, Drummond further discloses wherein the step of determining that the payment media handling operation event has occurred comprises performing at least one of a payment media handling apparatus self-diagnostic action and a payment media handling apparatus self-correcting action (see ¶0151 - ¶0154; ¶0163).

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685